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OCT 23 2002

Technology Center 2100

In re Application of: Bell

Serial No. 09/357,720

Filed: July 21, 1999

Group Art Unit: 2152

Examiner: Vu, Thong H.

**For: System and Method for Communicating in a
Point-to-Multipoint DSL Network**

The following is a list of documents enclosed:

Return Postcard
Appeal Brief
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10/25/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:)
)
Russell Bell) Art Unit: 2152
)
Serial No.: 09/357,720) Examiner: Thong H. Vu
)
Filed: July 21, 1999) Docket No. 60704-1870
)
For: System and Method for) Appeal No.: _____
Communicating in a)
Point-to-Multipoint DSL Network)

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Technology Center 2100

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This is an appeal from the decision of Examiner Thong H. Vu in Group Art Unit 2152, of May 10, 2002, rejecting claims 1-12 in the present application and making the rejection Final.

I. REAL PARTY IN INTEREST

The real party in interest of the instant application is GlobespanVirata, Inc., having its principal place of business at 100 Schulz Drive Red Bank, New Jersey 07701.

II. RELATED APPEALS AND INTERFERENCES

There are no other related appeals or interferences.

III. STATUS OF THE CLAIMS

Claims 1-12 are currently pending in the application. More specifically, the FINAL Office Action mailed May 10, 2002, rejected claims 1-12 under 35 U.S.C. §103 as being obvious over U.S. Patent No. 5,315,592 to Conant *et al.* (hereinafter, "*Conant*"), in view of U.S. Patent No. 6,067,561 to Dillon (hereinafter, "*Dillon*").

For the reasons set forth herein, the Applicant respectfully submits that the rejection of pending claims 1-12 should be overturned by the Board of Patent Appeals.

IV. STATUS OF AMENDMENTS

No amendments have been made after the issuance of the FINAL Office Action, and all amendments submitted before the issuance of the FINAL Office Action have been entered.

V. SUMMARY OF THE INVENTION

The present application is directed to a system and method for communicating in a point-to-multipoint DSL communication network 100 (FIG. 2). Preferably, the point-to-multipoint communication network is established in the environment of a home or small office (p.9, lines 10-11), and embodiments of the invention are realized through a computer 112 that may dynamically establish both local area network (LAN) and wide area network (WAN) communications (p.9, lines 15-19). Broadly, the system and method are realized by a computer

112 that is configured to assume a role as either a Master or Slave on a LAN. If the computer 112 is the first (or only) computer powered-up by the LAN then it assumes the role of Master (p.10, line 11-13). In this role, the computer 112 establishes a communication link with a WAN (such as with an Internet service provider) (p.18, lines 5-7), and directs all WAN communications over the WAN, using a WAN frequency and protocol (such as digital subscriber line (DSL)). As other computers join the LAN, WAN communications from those computers are relayed from the Master to the WAN. These communications are relayed to the Master using a LAN frequency band (p.16, line 17-p.17, line 1). If upon power-up, however, another computer is identified as already being on the LAN (and configured as a Master), then the computer 112 assumes a Slave configuration (p.17, lines 1-2). In this configuration, all WAN communications are directed to the WAN by way of the Master computer, and are communicated to the Master computer using a LAN frequency band (p.16, line 17-p.17, line 1). Return communications, received from the WAN, however, are broadcast directly over the LAN using the downstream frequency band of the DSL service (as opposed to the LAN frequency band) where they may be received by the appropriate Slave computer (p.16, lines 6-11).

VI. CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The issue in this appeal is whether claims 1-12 are unpatentable under 35 U.S.C. §103(a).

VII. GROUPING OF THE CLAIMS

The claims are divided into four (4) claim groupings, as set out below. For purposes of the argument set forth in this appeal brief, one claim from each group will be evaluated and discussed in detail in connection with the prior art. The claim groups include:

- (1) Claim Group I, which comprises claims 1, 2, 5, 6, 7, 9, and 12;
- (2) Claim Group II, which comprises claims 3 and 10;
- (3) Claim Group III, which comprises claims 4 and 11; and
- (4) Claim Group IV, which comprises claim 8.

Reasons that Claim Groups Do Not Stand or Fall Together

Although, in reality, all claims of an application are distinct, the Applicant has grouped the claims of the present application into four distinct claim groups. The reason that the claims for any given group do not stand or fall with any claims of another group is, ultimately, because they are of differing scope.

Starting with the claims of Group I, claim 1 includes elements such as, “directing outgoing WAN communications from any of the Slave computers to the WAN communications link, via the Master computer,” that are not present in the other claims. If the Board determines that the applied prior art does not disclose this additional element, then the claims of Group I will be allowable, independent of the claims of the other claim groups.

Regarding Group II, claims 3 and 10 are directed to the LAN frequency band being located at a higher than range than the WAN frequency band. If the Board determines that the applied prior art does not disclose this additional element, or that there is legally-insufficient

motivation for the combination of the selected features from the Conant and Dillon references, then the claims of Group II will be allowable, independent of the claims of the other claim groups.

Regarding Group III, claims 4 and 11 are directed to the WAN frequency band being a DSL frequency band. If the Board determines that the applied prior art does not disclose this additional element, or that there is legally-insufficient motivation for the combination of the selected features from the Conant and Dillon references, then the claims of Group III will be allowable, independent of the claims of the other claim groups.

Regarding Group IV, claim 8 is directed to third logic configured to determine whether any other computer is presently in communication with a local area network (LAN) and fourth logic configured to establish wide area network (WAN) communications from a computer within a WAN frequency band, if the third logic indicates that no other computer is presently in communication with the LAN. If the Board determines that the applied prior art does not disclose these additional elements, or that there is legally-insufficient motivation for the combination of the selected features from the Conant and Dillon references, then the claim of Group IV will be allowable, independent of the claims of the other claim groups.

VIII. ARGUMENT

A. Rejection of Claims 1-12 Under 35 U.S.C. §103

1. Case Law of 35 U.S.C. §103

For a claim to be properly rejected under 35 U.S.C. §103, "[t]he consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary

skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.” In re Dow Chemical Company, 837 F.2d 469, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Indeed, it is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. §103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551, 202 USPQ2d 303 (Fed. Cir. 1983). More significantly,

[b]oth the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention.

(Emphasis Added). In re Dow Chemical Company, *supra*.

Therefore, in order to sustain an obviousness rejection under 35 U.S.C. §103,

[t]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed.

Hartness International, Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108, 2 USPQ2d 1826 (Fed. Cir. 1987).

Accordingly, the prior art must properly disclose, teach, or suggest the desirability of combining the particular elements to teach or suggest at least the directing outgoing WAN communications from any of the Slave computers to the WAN communications link, via the Master computer, as claimed by the Applicant.

To better illustrate the foregoing concepts, the Applicant refers to Continental Can Co., USA, Inc. v. Monsanto Co., 948 F.2d 1264 (Fed. Cir. 1991). In that case, the claimed invention was directed to a ribbed bottom structure for reinforcing a plastic container. The patent in suit claimed that each container rib was hollow. The prior art consisted of several patents directed to ribbed configurations comprising the support structure of plastic container bottoms. The primary reference was a patent to Marcus, which disclosed a plastic container having a ribbed bottom, wherein the ribs were solid. A secondary reference was a patent disclosing a petaloid container, which, when inverted, closely resembled the claimed invention. The Federal Circuit, however, quickly dismissed this simple modification as constituting an obvious change by stating that "[a]lthough a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down." *Id.* at 1270.

Several prior art references in the *Continental Can* case disclosed plastic containers having ribbed bottoms, wherein the ribs were hollow. In rejecting the notion that elements from prior art references can be mixed and matched randomly in an effort to render obvious the claimed invention, the Federal Circuit stated that "[w]hen prior art references require selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Id.* at 1271. "The criterion of 35 U.S.C. §103 is not whether the differences from the prior art are simple enhancements, but whether it would have been obvious to make the claimed structure." *Id.* at 1273.

Finally, "[t]he PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citations omitted).

2. **Claim Group I**

a. **Conant In View Of Dillon Fails To Disclose, Teach, Or Suggest Each Element Of The Claims**

1. **Claim 1**

Paragraph 3 of the FINAL Office Action rejected claim 1 under 35 U.S.C. §103 as allegedly being obvious over *Conant* in view of *Dillon*.

The Applicant respectfully submits that independent claim 1 is distinguishable over the present references in that independent claim 1 recites steps that are neither disclosed, taught, nor suggested by the prior art of record. Independent claim 1 is set forth below.

Independent claim 1 provides as follows:

1. A method for communicating in a point to multi-point digital subscriber line (DSL) network, comprising the steps of:
 - electrically connecting a local loop to customer premises wiring;
 - establishing intra-LAN computer communications among a plurality of computers located at the customer premises, over the customer premises wiring, in a LAN frequency band, wherein one of the plurality of computers is configured as a Master computer and the remaining computers are configured as Slave computers;
 - establishing a WAN communications link between the Master computer located at the customer premises and a line card located at a central office, across the local loop, wherein communications between the Master computer and the central office occur in a WAN frequency band;

directing outgoing WAN communications from any of the Slave computers to the WAN communications link, via the Master computer; and receiving incoming WAN communications directly at any of the Slave computers.

(Emphasis added.)

The FINAL Office Action stated that:

As per claims 1, 7 and 9 Conant discloses a method for communicating in a point to multi-point digital subscriber line (DSL) network, comprising the steps of:

electrically connecting a local loop to customer premises wiring [Conant col 3 lines 36-62, col 4 lines 1-10];

configuring the computer as a Slave computer on the LAN, if at least one other computer is detected as being in communication with the LAN [Conant col 11 lines 40-67];

establishing a WAN communications link between the Master computer located at the customer premises and a line card located at a central office, across the local loop, wherein communications between the Master computer and the central office occur in a WAN frequency band; [Conant col 3 lines 9-35, col 5 lines 15-43, col 6 lines 8-36, col 11 lines 40-67, col 12 line 37-col 13 line 15]. Examiner takes an Official Notice that the DSL network is well-known in the network as inherent feature of WAN link [see Liu, Veerina references].

However Conant is silent on directing outgoing WAN communications from any of the Slave computers to the WAN communications link, via the Master computer; and receiving incoming WAN communications directly at any of the Slave computers.

A skilled artisan would have looked to the Wide area network art to implement the Conant's apparatus and found Dillon's teaching. Dillon taught a network environment wherein a client sends requests through a server which is connected to a front end computer (WAN link) and the front end computer sends a notification or response directly to client machine [Dillon Fig 1-2].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of sending request indirectly through a computer and receiving the response directly from a WAN link as taught by Dillon ino Conant's apparatus in order to utilize the LAN/WAN links. Doing so would provide the quick, simple and efficient process to communicate between source and destination on wide area network.

(Emphasis added.)

The foregoing rejection is erroneous, and Applicant respectfully submits that it should be overturned by the Board.

In contrast to the allegations of the Office Action, *Conant* discloses a network with parallel bridges that transmits information packets over parallel paths between first and second terminals in a network having other terminals while maintaining conformity with a protocol that precludes establishing loops formed by links between terminals that allow information packets to recirculate indefinitely. *Conant* defines bridges as connecting a first LAN to a second LAN by using LAN links. Bridges establish parallel communication paths between a plurality of computer stations on the first LAN and a plurality of computer stations on the second LAN. Therefore, it is abundantly clear that the bridges of *Conant* provide for inter-LAN connections.

There is a first pair of bridges with each bridge connected to a respective one of the first and second terminals and interconnected by a second link. At least one bridge in each of the first pair of bridges and the second pair of bridges is designatable as a Master bridge.

Dillon does not supply the needed, missing teachings. In this regard, *Dillon* discloses an e-mail notification system that notifies a subscriber when an email server has received an email message for the subscriber. To notify the subscriber, *Dillon* includes an e-mail server for administering an e-mail account of an e-mail service subscriber and an e-mail alert front-end.

In contrast to both *Conant* and *Dillon*, the Applicant's invention is directed to a system and method for directing outgoing WAN communications from any Slave computer to a WAN communications link, via a Master computer.

With particular regard to the claims, independent claim 1 includes the step of: ***"directing outgoing WAN communications from any of the Slave computers to the WAN communications link, via the Master computer."***

The Applicant respectfully submits that *Conant* in view of *Dillon* fails to disclose, teach, or suggest directing outgoing WAN communications from any Slave computer to a WAN communications link, via a Master computer.

It is well established that an "[a]n applicant is ordinarily entitled to be his own lexicographer, so long as his meaning is clear." *In re Castaing and Slodzian*, 429 F.2d 461, 166 U.S.P.Q. 550, 551 (C.C.P.A. 1970). Given this, the Applicant submits that the terms used in *Conant* are not synonymous with the terms used by the Applicant. Furthermore, the Applicant submits that because *Conant's* definition so diverges with the Applicant's definition of certain terms, it is **impossible** to direct an outgoing communication from *Conant's* "slave bridge" to the WAN through *Conant's* "master bridge." For at least this reason, the Applicant submits that *Conant* is not a proper reference. See, e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (If a reference would be "rendered inoperable for its intended purpose" when it is modified for use as prior art, then the reference "teaches away" and should not be used).

It appears as if the Office Action uses *Conant's* "bridge" interchangeably with the Applicant's "computer." However, as taught by *Conant*, these terms are neither synonymous nor

interchangeable. *Conant* specifically defines bridges as being "connected to different LANs and connected to each other by at least one WAN link." *Conant* at col. 3, lines 46-47. Thus, rather than providing an intra-LAN connection, bridges, as defined by *Conant*, provide inter-LAN connections. In this sense, *Conant's* "bridges" share no commonality with the Applicant's "computers." Additionally, FIGS. 1 and 3 of *Conant* clearly show computer stations 54, 56 connected to LANs. Thus, even *Conant* does not use these terms interchangeably.

Additionally, *Conant's* definition of a "slave" and the Applicant's definition of a "Slave" are neither interchangeable nor synonymous. Specifically, *Conant* defines the "bridges" on the same LAN as the master bridge (*i.e.*, intra-LAN "bridges") as "peer bridges," and not as "slave bridges." Those "bridges" that are on different LANs (*i.e.*, inter-LAN) are designated as "slave bridges." *Conant* at col. 6, lines 26-30. The Applicant, on the other hand defines a "Slave" as being on the same LAN as a "Master" (*i.e.*, intra-LAN). Thus, given *Conant's* definition of "slave bridges," the Applicant submits that it would be impossible to direct an outgoing communication from *Conant's* "slave bridge" to the WAN through *Conant's* "master bridge."

Pending claim 1 recites the step of "directing outgoing WAN communications from any of the Slave computers to the WAN communications link, via the Master computer." Thus, claim 1 teaches that an outgoing communication from a "Slave computer" is directed to a WAN via a "Master computer," which is on the same LAN as the "Slave computer." To the contrary, it would be impossible to direct an outgoing communication from *Conant's* "slave bridge" to the WAN through *Conant's* "master bridge" because *Conant's* "slave bridge" is not on the same LAN as *Conant's* "master bridge." Thus, should an outgoing communication from *Conant's* "slave bridge" be

directed to the WAN using *Conant's* "master bridge," it would be necessary for the communication to cross the WAN from *Conant's* "slave bridge" to *Conant's* "master bridge" and then be directed, again, to the WAN. Regardless of how one looks at *Conant's* system, it is **impossible** to direct a communication from *Conant's* "slave bridge" to the WAN using *Conant's* "master bridge."

Thus, regardless of what other references may be used in combination, because it is **impossible** to direct a communication from *Conant's* "slave bridge" to the WAN using *Conant's* "master bridge," the Applicant respectfully submits that the above-emphasized element of claim 1 is not disclosed, taught, or suggested by *Conant* in view of *Dillon*. For at least this reason, the Applicant respectfully submits that claim 1 is in condition for allowance.

Accordingly, the Applicant respectfully submits that independent claim 1 is allowable in that it recites steps that are not disclosed, taught, or suggested by *Conant* in view of *Dillon*. For this reason alone, the rejection of claim 1 should be overturned by the Board.

As a separate and independent basis for the patentability of claim 1, and as asserted by the Applicant in his first response, the Office Actions have repeatedly failed to cite a legally-satisfactory motivation (as required under 35 U.S.C. § 103) to combine *Conant* and *Dillon*. In this regard, the Applicant refers to the recent Federal Circuit decision of *In re Sang-Su Lee*, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). As clearly articulated in this Appeal Brief, general conclusions of obviousness will not be upheld, without clear evidentiary facts to support them. In this regard, Office Action rejections "cannot rely on conclusory statements when

dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.” The Sang-Su Lee opinion further states that Office Actions “must make findings of facts, and present [their] reasoning in sufficient detail that [a] court may conduct meaningful review of the agency action.”

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, the Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also **requires the prior art to suggest both the combination of elements and the structure resulting from the combination.** Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to direct outgoing WAN communications from any Slave computer to a WAN communications link, via a Master computer, as claimed by the Applicant. "Particular findings must be made as to

the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

"A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000)) (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)); The Federal Circuit has made it clear "that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999). Thus, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998).

In the present application, the Office Action has clearly failed to satisfy this evidentiary standard, which the Federal Circuit, in In re Sang-Su Lee, held that the Administrative Procedures Act mandates. For example, in rejecting claim 1, the FINAL Office Action stated, in response to the Applicant's argument that there is not motivation or suggestion to combine:

... [I]n response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Conant discloses a WAN/LAN

environment including the master bridge and slave bridge, loop circuitry. However Conant does not detail the DSL modem, direct transmission. Dillon discloses a WAN/LAN environment using modem and direct communication such as satellite communication [Dillon Fig 1-2]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of communication directly from a WAN link as taught by Dillon into Conant's apparatus in order to utilize the LAN/WAN links. Doing so would provide the quick, simple and efficient process to communicate between source and destination on wide area network.

This is the total of the argument and reasoning set forth by the Office Action in reaching the conclusion that one would have been led to combine the divergent teachings of *Conant* and *Dillon*. The Applicant respectfully submits that this falls far short of the legal requirement articulated by the Federal Circuit in *In re Sung-Su Lee*. For this independent reason, the rejections of the Office Action should be overturned and claim 1 should be allowed.

3. **Claim Group II**

Paragraph 11 of the FINAL Office Action rejected claims 3 and 10 under 35 U.S.C. §103 as allegedly being obvious over *Conant* in view of *Dillon*.

The Applicant respectfully submits that claim 3 is distinguishable over the present references in that claim 3 recites an element that is neither disclosed, taught, nor suggested by the prior art of record.

Claim 3 specifically recites:

3. The method as defined in claim 1, wherein the LAN frequency band is located at a higher than range that the WAN frequency band.

The FINAL Office Action specifically stated:

As per claims 3 and 10 Conant-Dillon disclose the LAN frequency band is located at a higher than range that the WAN frequency band [Conant col 3 lines 9-35, col 5 lines 15-43, col 6 lines 8-36, col 11 lines 40-67, col 12 line 37-col 13 lines 15].

The Applicant, however, has closely reviewed the cited portions of Conant, and has found no such teaching. It should be fundamentally recognized that the Conant reference is directed to a bridge, which is an interconnection (or bridge) between communications of two different local area networks (LANs). As such, one would not expect to find the teachings of the claimed invention (namely a computer that hosts both LAN and WAN communications). Indeed, these teachings are fundamentally absent from Conant.

Even a cursory reading of the cited portions of Conant reveals that the claimed feature (*i.e.*, the LAN frequency band being higher than that WAN frequency band) is absent from the Conant patent. For this reason alone, the rejection is legally-erroneous and should be overturned.

4. Claim Group III

Paragraph 12 of the FINAL Office Action rejected claims 4 and 11 under 35 U.S.C. §103 as allegedly being obvious over *Conant* in view of *Dillon*.

The Applicant respectfully submits that claim 4 is distinguishable over the present references in that claim 4 recites an element that is neither disclosed, taught, nor suggested by the prior art of record.

Claim 4 specifically recites:

4. The method as defined in claim 1, wherein the WAN frequency band is a DSL frequency band.

The FINAL Office Action stated:

As per claims 4 and 11 Conant-Dillon disclose the WAN frequency band is a DSL frequency band as inherent feature of WAN link [Conant col 3 lines 9-35, col 5 lines 15-43, col 6 lines 8-36, col 11 lines 40-67, col 12 line 37-col 13 line 15].

The Applicant, however, has closely reviewed the cited portions of Conant, and has found no such teaching. It should be fundamentally recognized that the Conant reference is directed to a bridge, which is an interconnection (or bridge) between communications of two different local area networks (LANs). As such, one would not expect to find the teachings of the claimed invention (namely a computer that hosts both LAN and WAN communications). Indeed, these teachings are fundamentally absent from Conant.

Even a cursory reading of the cited portions of Conant reveals that the claimed feature (*i.e.*, that WAN frequency band is a DSL frequency band) is absent from the Conant patent. For this reason alone, the rejection is legally-erroneous and should be overturned.

5. Claim Group IV

Paragraph 16 of the FINAL Office Action rejected claim 8 under 35 U.S.C. §103 as allegedly being obvious over *Conant* in view of *Dillon*.

The Applicant respectfully submits that claim 8 is distinguishable over the present references in that claim 8 recites elements that are neither disclosed, taught, nor suggested by the prior art of record.

Claim 8 specifically recites:

8. The system as defined in claim 7, further including:
third logic, operable upon a reset condition, configured to determine whether any other computer is presently in communication with the LAN;

fourth logic configured to establish WAN communications from the computer within a WAN frequency band, if the third logic indicates that no other computer is presently in communication with the LAN;

The FINAL Office Action stated:

As per claim 8, Conant-Dillon disclose third logic, operable upon a reset condition, configured to determine whether any other computer is presently in communication with the LAN; fourth logic configured to establish WAN communications from the computer within a WAN frequency band, if the third logic indicates that no other computer is presently in communication with the LAN as inherent features of reset logic on bridges [Conant col 9 lines 6-15].

In contrast to the teachings of both *Conant* and *Dillon*, the present invention (as defined in claim 8) includes logic, operable upon a reset condition, configured to determine whether any other computer is presently in communication with the LAN, and logic configured to establish WAN communications from the computer within a WAN frequency band, if the third logic indicates that no other computer is presently in communication with the LAN.

Simply stated, neither *Conant* nor *Dillon* (nor the combination of the two) discloses, teaches, or suggests these elements. Specifically, portions of *Conant* specifically relied upon by the Office Action do not disclose the recited elements of claim 8.

Accordingly, the Applicant respectfully submits that claim 8 is allowable in that it recites elements that are not disclosed, taught, or suggested by *Conant* in view of *Dillon*, and the Board should overturn the Examiner's rejection.

IX. CONCLUSION

In view of the foregoing, it is believed that all pending claims 1-12 are in proper condition for allowance, and the Board is respectfully requested to overturn the Examiner's rejections of these claims.

We are enclosing a check in the amount of \$320.00 for filing this Appeal Brief. If any additional fees are required for this Appeal Brief, you are hereby authorized to charge any additional fee that may be required to deposit account 20-0778.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
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